

REMARKS

This Response is submitted in reply to the Office Action dated June 27, 2003. Claims 13, 14, 17, 18, 19, 20, 21, 36, 37 to 40, 42 to 50 have been amended. Claim 53 has been canceled. New claims 54 and 55 have been added. The amendments to the claims are to clarify the language of the claims and not for any reasons of patentability. No new matter has been added by any of the amendments made herein. A Petition for a Two-Month Extension of Time to Respond to the Office Action is submitted herewith. A check in the amount of \$504.00 is submitted to cover the fees for the two-month extension and the new claims in this Response. Please charge deposit account no. 02-1818 for any insufficiency or to credit any overpayment.

Claims 1 to 14, 17 to 35, 41 and 51 to 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Japanese Publication No. 10-052558 to Takatoshi ("*Takatoshi*") in view of U.S. Patent No. 5,400,990 to *Frankel* ("*Frankel*"). Claims 20 to 21, 36 to 39, 42 to 50 and 53 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Frankel*.

Claims 1 to 14, 17 to 35, 41 and 51 to 52 were rejected as being unpatentable over *Takatoshi* in combination with *Frankel*. Applicants respectfully disagree with and traverse this rejection.

I. *Frankel* is Non-Analogous Art

Applicants respectfully submit that this combination is improper because *Frankel* is non-analogous art. To determine whether a claim would have been obvious at the time of the invention, one must first determine the scope and content of the prior art. *Graham v. John Deere Company*, 383 U.S. 17, 148 U.S.P.Q. 459, 467 (1966). This determination is frequently couched in terms of whether the art is analogous or non-analogous (i.e., whether the art is too remote from the field of the invention to be treated as prior art). *In re Clay*, 966 F.2d 656, 658, 23 U.S.P.Q.2d 1058, 1060 (Fed. Cir. 1992). A copy of this case is attached for the convenience of the Examiner. Art is considered analogous to an invention when it is from (1) the same field of invention or (2) if it is reasonably pertinent to the particular problem to be solved. *Id.* Moreover, a reference

is "reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commanded itself to an inventor's attention in considering his problem". *Id.*

In the Office Action, the Patent Office states that *Takatoshi* discloses all of the elements of the claimed invention except "a container holder having a bottom surface and an item holder including means for enabling a player to securably and removably connect an item to the item holder having the item holder projecting from the bottom surface of the container holder as recited in claims 1, 13, 22, 26, 41 and 51 to 52..." (See the Office Action, page 2-3). The Patent Office therefore relies on *Frankel* to remedy the deficiencies of *Takatoshi*. *Frankel*, however, is non-analogous art and therefore cannot be properly combined with *Takatoshi* to render the claimed invention obvious. As described above, art is analogous to an invention when it is from the same field as the claimed invention or if it is reasonably pertinent to the particular problem to be solved.

✓ *Frankel* is clearly not from the same field of invention as the claimed invention. *Frankel* is directed to a handle support assembly that is attached to handles, bars, shafts or the like on strollers, shopping carts and similar devices for holding a container and other loose articles. *Frankel* does not disclose, teach or suggest that the assembly of *Frankel* can or may be used for a gaming device or in the gaming industry. Therefore, the handle support assembly in *Frankel* is not from the same field as the claimed invention.

Additionally, the invention disclosed by *Frankel* is also not reasonably pertinent to the particular problem to be solved. As described above, a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which logically would have commanded itself to an inventor's attention in considering his problem.

✓ Gaming establishments have very limited space and the gaming devices in the establishments have limited surface or counter space. The problems associated with these conditions are described in the present patent application as follows:

Certain gaming areas or casinos are crowded because certain gaming owners maximize the number of gaming devices in their gaming area, leaving small amounts of space around the device for the player's personal use or to accommodate the player's personal items or belongings.

Gaming establishment owners want players to feel as comfortable and secure as possible while playing the gaming devices. However, the limited space in the gaming area provides little room for players to place or secure their personal items. Players also sometimes carry containers for drinks or tokens, and players either hold the containers or balance the containers on any available surface near the gaming device. Players also generally hold onto their personal items such as bags, purses and fanny packs, placing them on the gaming devices to keep them in their line of site or placing them under their chairs or stools (if provided) to prevent these items from being stolen.

Known gaming devices include drink holders to accommodate the players' drink containers. However, there are no known gaming devices which include a removable device that accommodates both containers and personal items such as bags, purses, coats and umbrellas. (page 1, line 9 to page 2, line 2)

- ✓ Thus, security of a player's personal items and specifically, the theft or taking of a player's personal items is a major issue or problem faced by gaming manufacturers. The combined container-item holder of the present invention solves this problem by enabling a player to secure purses, shopping bags or other personal articles or items to the hook of the container item holder while the player plays a gaming device. Because of the limited space issues, the securing portion or hook attached to the bottom surface of the container-item holder holds and secures a player's personal items such as purses, shopping bags, belly packs, umbrellas or other articles to prevent these articles from being stolen or accidentally taken while the player's attention is directed to a game associated with a gaming device and not on their purse, bag or other personal items. Without the hook or securing portion on the bottom of the container-item holder of the present invention, a player has to place their purses, shopping bags or other personal articles on the floor, between machines or on their chair. These articles are therefore more susceptible to being stolen or accidentally taken while the player's attention is diverted away from the articles and directed at the game displayed by the gaming

device. Therefore, the claimed gaming device including the combined container-item holder solves the above-identified security problem by giving players a place to securely hold their personal items to a gaming device while the player plays a game associated with the gaming device.

- ✓ The apparatus described by *Frankel* does not address the same problem or even suggest any solutions to the problem solved by the claimed invention. The handle support assembly in *Frankel* includes, in one embodiment, a beverage container holder 250 and a hook member 262 connected to the bottom of a beverage container holder (See Fig. 25 of *Frankel*). The assembly is generally attached to bars or supports of "strollers, buggies, bicycles, carts, and other conventional ambulatory assistance devices." (*Frankel*, Col. 4, lines 45 to 50) *Frankel* states that the cup-like portion of the handle support assembly is used to store "baby bottles, cold drinks and the like . . . during use of the present invention." (Col. 9, lines 55 to 59) Additionally, the hook portion of the assembly enables a user to hold a purse, sweater, towel or similar articles so that the "portion of handle 12 adjacent and on either side of the article support assembly 10 is available for conventional securement by the hands of the user for control of stroller 52." (Col. 5, lines 49 to 55) Furthermore, the assembly enables a user to be able to deal with a child that is seated in the stroller, cart or the like. (Col. 5, lines 44 to 47). The purpose of the handle support assembly is therefore to enable a user to position a beverage container in the assembly and also to support or carry other loose articles such as purses or shopping bags as a convenience for the user so that the user can control and maneuver the stroller or cart, or attend to their child. *Frankel* is not concerned with the theft or taking of the loose articles from the stroller or cart. *Frankel* does not disclose such a problem nor does *Frankel* teach or suggest a solution to such a problem. Accordingly, a person faced with the problem of securely holding loose articles on a gaming device to prevent theft or taking of the articles would not consider the assembly described by *Frankel* when *Frankel* does not address the theft of personal items from a stroller or where *Frankel* does not teach or suggest a solution to such a problem. Therefore, *Frankel* is not reasonably pertinent to the problem to be

solved by the gaming device including the combined container-item holder of the claimed invention.

Accordingly, for the reasons provided above, *Frankel* does not satisfy either of the two tests for determining that a reference is analogous art. Thus, *Frankel* is non-analogous art and is improperly combined with *Takatoshi* to render the claimed invention obvious.

II. *Takatoshi* and *Frankel* were combined using Improper Hindsight

Even if *Frankel* is considered analogous art, it is respectfully submitted that the Office Action improperly combines *Takatoshi* with *Frankel* to achieve the claimed invention. It is impermissible to use the claims as an instruction manual or template to piece together the teachings of the prior art to render a claimed invention obvious. *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed. Cir. 1996). "Virtually all [inventions] are combinations of old elements." *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457. An Examiner may often find every element of a claimed invention in the prior art. However, if "merely identifying each claimed element in the prior art was sufficient to negate patentability, very few patents would ever issue". *Id.* Rejecting patent claims solely by finding "prior art corollaries" for the claimed elements permits an examiner to use the claimed invention itself as a blueprint for piecing elements in the prior art together. *Id.* To defeat the patentability of a patent application in this manner is inappropriate. Therefore, the Patent Office must show the "reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art" and combine those elements in the same manner as the claimed invention. *Id.* Neither *Takatoshi* nor *Frankel* includes a motivation, suggestion or teaching for the desirability of making the specific combination as set forth in the Office Action.

✓ *Takatoshi* is directed to a tray member for a game machine island, which includes a main body 20 having various compartments. The body 20 is attached to top plate B using a clip 31. Alternatively, the body may be attached to the top plate using

screw thread 33 (see Fig. 3 of *Takatoshi*). *Takatoshi*, however, does not disclose, teach or suggest a hook or similar device for securing loose articles such as shopping bags or purses to the main body 20. In addition, *Frankel* does not disclose, teach or suggest using the handle support assembly with a gaming device or other similar device to hold beverage containers and also loose articles such as purses. Additionally, *Frankel* specifically teaches that the handle support assembly is attached to handle or similar support of ambulatory assistance devices. This is contrary to the present invention because for a stationary item such as a gaming device, there is no need to carry a player's personal items for the same purpose as in *Frankel*. Moreover, *Frankel* does not teach or suggest that the handle support assembly may be inserted into a corresponding receptacle, attached to a support such as a counter or any other type of use. The handle support assembly is strictly used for strollers, carts and other similar devices. For these reasons, a person of ordinary skill in the art would not be motivated to combine *Takatoshi* with *Frankel* to achieve the claimed invention where there is no teaching or suggestion in either reference to make such a combination. Furthermore, Applicant respectfully submits that such additional motivation or suggestion can only be derived from improper hindsight.

The M.P.E.P. mandates that impermissible hindsight must be avoided and the legal conclusion of obviousness must be reached on the basis of the facts gleaned from the prior art (See M.P.E.P. §2141.03). Although, as stated in case law often relied on by the U.S. Patent Office (See e.g., paragraph A of subsection X of § 2145 of the M.P.E.P.), that “[a]ny judgment of obviousness is in a sense necessarily a reconstruction based on hindsight reasoning” *In re MacLaughlin* 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212 (CCPA 1971), this nonetheless does not relieve the Patent Office of ensuring that the obviousness determination takes into account only knowledge which was with the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned from the applicant's disclosure. The Patent Office has not submitted any reason why a person of ordinary skill in the art would be motivated to combine these two references other than the fact

that *Frankel* describes a container holder that includes a hook portion. Applicant's fail to see why one of ordinary skill in the art would consider *Frankel*.

Applicant submits that one of ordinary skill in the art at the time of invention would not be motivated based on these references to specifically modify a divided compartment or holder for a slot machine to include a hook or similar securing portion based on *Frankel*. The rationale provided by the Office Actions does not explain why one of ordinary skill in the art would be specifically motivated to make such a combination. As a result, Applicant respectfully submits that *Takatoski* and *Frankel* were combined using impermissible hindsight which is inappropriate and cannot be the basis for combining these references.

For all of the above reasons, Claims 1 to 14, 17 to 35, 41, and 51 to 52 are patentably distinguished over the combination of *Takatoshi* and *Frankel* and are in condition for allowance.

Regarding the rejection of Claims 20 to 21, 36 to 39, 42 to 50 and 53, *Frankel* is non-analogous art and therefore cannot be the basis for rejecting these claims. As described above, *Frankel* discloses a handle support assembly which enables a user to hold a beverage container and any loose articles such as a purse or sweater while operating a device such as a stroller or shopping cart. The purpose of the handle support assembly is to provide a safe and convenient way to enable a user to free up their hands to control and/or maneuver the shopping cart or stroller. *Frankel* does not disclose, teach or suggest that the handle support assembly is for the purpose of preventing theft or the taking of the loose articles from the stroller or shopping cart. Therefore, one of ordinary skill in the art would not be motivated to take the handle support assembly of *Frankel* to achieve the claimed invention. For these reasons, Claims 20, 36, 42 and 53, and Claims 21, 37 to 39, 43 to 50, which depend from these claims, are each patentably distinguished over *Frankel* and are in condition for allowance.

New Claim 54 includes similar elements to the other independent claims. Specifically, new Claim 54 is directed to a combined container item holder for a gaming device including a cabinet and a bolster connected to the cabinet. The bolster includes

a substantially vertically extending channel. The container item holder includes a container holder mounted in the channel, where the container holder has a bottom surface. The container holder also defines a body having at least one opening to enable fluid to drain from the container holder and a flange connected to the body where the flange has a circumference greater than the circumference of the channel. The container item holder also includes at least one hook projecting from the bottom surface of the container holder where the hook includes a relatively straight connecting portion and a securing portion connected to the connecting portion. The securing portion enables a player to securely and removably connect at least one item to the hook. Additionally, the securing portion includes an inhibiting device for inhibiting the item from being easily removed from the item holder. As described above, neither of the cited references disclose, teach or suggest a container item holder having these elements. Specifically, neither of the references disclose, teach or suggest a container item holder including an inhibiting device for inhibiting an item from being easily removed from the item holder.

Therefore, for all of the above reasons, new claim 54 and new claim 55, which depends from new claim 54, are each patentably distinguished over the cited references and are in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art, such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully request that the Examiner contact the undersigned.

Respectfully submitted,

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pertinent question is if the asserted claims of the '445 and '062 patents are interpreted broadly enough to cover the New Striker, would they have been allowed by the Patent Examiner over the prior art. "If not, then it would be improper to permit [the patent holder] to obtain that coverage in an infringement suit under the doctrine of equivalents." *Id.* The burden is upon the patent holder to prove that the range of equivalents it propounds would not ensnare the relevant prior art. *Id.* at 685.

The second limitation on equitable infringement is prosecution history estoppel. Such estoppel prevents a plaintiff in an action for infringement, under the doctrine of equivalents, from interpreting claims so as to include subject matter that the inventor disclaimed to obtain allowance of the claim before the Patent Office while prosecuting the application. *Standard Oil Co. v. American Cyanamid Co.*, 774 F.2d 448 [227 USPQ 293] (Fed. Cir. 1985). Not all disclaimers result in an estoppel, however. Rather, an estoppel will be found only when the patent holder's disclaimer was required in response to an examiner's rejection. *Mannesmann Demag Corp. v. Engineered Metal Prod.*, 793 F.2d 1279, 1284-85 [230 USPQ 45] (Fed. Cir. 1986).

[3] The court is not satisfied that the New Striker and Rawl Spike perform substantially the same function, in substantially the same way, to achieve substantially the same result. Contrary to Rawlplug's assertions, the evidence indicates that the New Striker's holding power does not result from a three point pressure system centered around a peak and two bases. Rather, it results from a combination of four points of pressure against the hole wall and a mechanical interlock between the serrations and the wall. This is in contrast to the Rawl Spike, whose two base pressure points are equal in force to that of its peak.

The mere fact that a competing device uses a pressure point system, in and of itself, would not be an infringement of Rawlplug's patents. Instead, it is the way the pressure system is employed that would determine whether infringement exists. Here the New Striker employs a different pressure system than the Rawl Spike. Indeed, the New Striker functions like a combination of the *Katou* and *Carroll*, both of which Giannuzzi distinguished from his invention during the prosecution process. To interpret the New Striker's use of pressure and mechanical interlock as infringing the '445 and '062 patents would be impermissible in light of this relevant prior art.

The complaint is dismissed, and judgment shall be entered in favor of the defendant.
So Ordered.

Court of Appeals, Federal Circuit

In re Clay

No. 91-1402

Decided June 10, 1992

PATENTS

1. Patentability/Validity — Obviousness — Relevant prior art — In general (§115.0903.01)

JUDICIAL PRACTICE AND PROCEDURE

- Procedure — Judicial review — Standard of review — Patents (§410.4607.09)

Board of Patent Appeals and Interferences' decision as to whether reference in prior art is "analogous" to invention under consideration is reviewed under clearly erroneous standard, since question is one of fact; resolution of question requires determination of whether reference is from same field of endeavor as invention, regardless of problem addressed, and if not, whether reference is nonetheless reasonably pertinent to particular problem with which inventor is involved.

PATENTS

2. Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Patent which discloses process for reducing permeability of hydrocarbon-bearing formations, and thus improving oil production, by using gel to plug formation anomalies is not in same field of endeavor as invention of application, which uses gel to fill dead volume of tank for storing refined liquid hydrocarbon product, even though reference and application relate to petroleum industry, since reference teaches use of gel in unconfined and irregular volumes within natural oil-bearing formations in order to channel flow in desired direction, whereas application teaches use of gel in confined dead volume of storage tank, since process of reference operates in extreme conditions, whereas application process operates at ambient pressures and temperatures, and since application thus relates to storage of refined

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liquid hydrocarbons, whereas reference concerns extraction of crude petroleum.

3. Patentability/Validity — Obviousness — Relevant prior art — In general (§115.0903.01)

Prior reference is reasonably pertinent to problem addressed by inventor in patent application, even though it may be in field different from that of inventor's endeavor, if reference, by reason of matter with which it deals, logically would have commended itself to inventor's attention in considering pertinent problem.

4. Patentability/Validity — Obviousness — Relevant prior art — Particular inventions (§115.0903.03)

Patent which discloses process for reducing permeability of hydrocarbon-bearing formations, and thus improving oil production, by using gel to plug formation anomalies is not reasonably pertinent to invention of application, which uses gel to fill dead volume of tank for storing refined liquid hydrocarbon product, since reference addresses problem of recovering crude oil from porous, permeable sedimentary rock matrix, whereas invention of application is directed to preventing loss of refined hydrocarbon product to dead volume of storage tank while preventing contamination of such product, since subterranean formation of reference is structurally and functionally dissimilar to storage tanks of patent, and since person of ordinary skill in art thus would not reasonably have expected to solve problem of dead volume in petroleum storage tanks by considering reference in question.

Appeal from the U.S. Patent and Trademark Office, Board of Patent Appeals and Interferences.

Patent application of Carl D. Clay, serial no. 245,083, filed April 28, 1987 (storage of refined liquid hydrocarbon product). From decision upholding examiner's rejection of all claims remaining in application, applicant appeals. Reversed.

Jack E. Ebel, Littleton, Colo. (Paul T. Meiklejohn, of Seed & Berry, Seattle, Wash., of counsel), for appellant.

Teddy S. Gron, associate solicitor (Fred E. McKelvey, solicitor, with him on the brief; Richard E. Schafer, of counsel), for appellee.

Before Plager, Lourie, and Clevenger, circuit judges.

Lourie, J.

Carl D. Clay appeals the decision of the United States Patent and Trademark Office,

Board of Patent Appeals and Interferences, Appeal No. 90-2262, affirming the rejection of claims 1-11 and 13 as being unpatentable under 35 U.S.C. § 103. These are all the remaining claims in application Serial No. 245,083, filed April 28, 1987, entitled "Storage of a Refined Liquid Hydrocarbon Product." We reverse.

BACKGROUND

Clay's invention, assigned to Marathon Oil Company, is a process for storing refined liquid hydrocarbon product in a storage tank having a dead volume between the tank bottom and its outlet port. The process involves preparing a gelation solution which gels after it is placed in the tank's dead volume; the gel can easily be removed by adding to the tank a gel-degrading agent such as hydrogen peroxide. Claims 1, 8, and 11 are illustrative of the claims on appeal:

1. A process for storing a refined liquid hydrocarbon product in a storage tank having a dead volume between the bottom of said tank and an outlet port in said tank, said process comprising:

preparing a gelation solution comprising an aqueous liquid solvent, an acrylamide polymer and a crosslinking agent containing a polyvalent metal cation selected from the group consisting of aluminum, chromium and mixtures thereof, said gelation solution capable of forming a rigid crosslinked polymer gel which is substantially insoluble and inert in said refined liquid hydrocarbon product;

placing said solution in said dead volume;

gelling said solution substantially to completion in said dead volume to produce said rigid gel which substantially fills said dead volume; and storing said refined liquid hydrocarbon product in said storage tank in contact with said gel without substantially contaminating said product with said gel and without substantially degrading said gel.

8. The process of claim 1 further comprising removing said rigid gel from said dead volume by contacting said gel with a chemical agent which substantially degrades said gel to a flowing solution.

11. The process of claim 1 wherein said gelation solution further comprises an aqueous liquid contaminant present in said dead volume which dissolves in said solution when said solution is placed in said dead volume.

Two prior art references were applied against the claims on appeal. They were U.S.

Patent 4,664,294 (Hetherington), which discloses an apparatus for displacing dead space liquid using impervious bladders, or large bags, formed with flexible membranes; and U.S. Patent 4,683,949 (Sydansk), also assigned to Clay's assignee, Marathon Oil Company, which discloses a process for reducing the permeability of hydrocarbon-bearing formations and thus improving oil production, using a gel similar to that in Clay's invention.

The Board agreed with the examiner that, although neither reference alone describes Clay's invention, Hetherington and Sydansk combined support a conclusion of obviousness. It held that one skilled in the art would glean from Hetherington that Clay's invention "was appreciated in the prior art and solutions to that problem generally involved filling the dead space with *something*." Opinion at 3 (emphasis in original).

The Board also held that Sydansk would have provided one skilled in the art with information that a gelation system would have been impervious to hydrocarbons once the system gelled. The Board combined the references, finding that the "cavities" filled by Sydansk are sufficiently similar to the "volume or void space" being filled by Hetherington for one of ordinary skill to have recognized the applicability of the gel to Hetherington.

DISCUSSION

The issue presented in this appeal is whether the Board's conclusion was correct that Clay's invention would have been obvious from the combined teachings of Hetherington and Sydansk. Although this conclusion is one of law, such determinations are made against a background of several factual inquiries, one of which is the scope and content of the prior art. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 USPQ 459, 467 (1966).

A prerequisite to making this finding is determining what is "prior art," in order to consider whether "the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103. Although § 103 does not, by its terms, define the "art to which [the] subject matter [sought to be patented] pertains," this determination is frequently couched in terms of whether the art is analogous or not, *i.e.*, whether the art is "too remote to be treated as prior art." *In re Sovish*, 769 F.2d 738, 741, 226 USPQ 771, 773 (Fed. Cir. 1985).

[1] Clay argues that the claims at issue were improperly rejected over Hetherington and Sydansk, because Sydansk is nonanalogous art. Whether a reference in the prior art is "analogous" is a fact question. *Panduit Corp. v. Dennison Mfg.*, 810 F.2d 1561, 1568 n.9, 1 USPQ2d 1593, 1597 n.9 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987). Thus, we review the Board's decision on this point under the clearly erroneous standard.

Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

The Board found Sydansk to be within the field of Clay's endeavor because, as the Examiner stated, "one of ordinary skill in the art would certainly glean from [Sydansk] that the rigid gel as taught therein would have a number of applications within the manipulation of the storage and processing of hydrocarbon liquids . . . [and that] the gel as taught in Sydansk would be expected to function in a similar manner as the bladders in the Hetherington patent." These findings are clearly erroneous.

[2] The PTO argues that Sydansk and Clay's inventions are part of a common endeavor — "maximizing withdrawal of petroleum stored in petroleum reservoirs." However, Sydansk cannot be considered to be within Clay's field of endeavor merely because both relate to the petroleum industry. Sydansk teaches the use of a gel in unconfined and irregular volumes within generally underground natural oil-bearing formations to channel flow in a desired direction; Clay teaches the introduction of gel to the confined dead volume of a man-made storage tank. The Sydansk process operates in extreme conditions, with petroleum formation temperatures as high as 115°C and at significant well bore pressures; Clay's process apparently operates at ambient temperature and atmospheric pressure. Clay's field of endeavor is the *storage* of refined liquid hydrocarbons. The field of endeavor of Sydansk's invention, on the other hand, is the *extraction* of crude petroleum. The Board clearly erred in considering Sydansk to be within the same field of endeavor as Clay's.

[3] Even though the art disclosed in Sydansk is not within Clay's field of endeavor, the reference may still properly be combined

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with Hetherington if it is reasonably pertinent to the problem Clay attempts to solve. *In re Wood*, 599 F.2d at 1036, 202 USPQ at 174. A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem. Thus, the purposes of both the invention and the prior art are important in determining whether the reference is reasonably pertinent to the problem the invention attempts to solve. If a reference disclosure has the same purpose as the claimed invention, the reference relates to the same problem, and that fact supports use of that reference in an obviousness rejection. An inventor may well have been motivated to consider the reference when making his invention. If it is directed to a different purpose, the inventor would accordingly have had less motivation or occasion to consider it.

[4] Sydans's gel treatment of underground formations functions to fill anomalies¹ so as to improve flow profiles and sweep efficiencies of injection and production fluids through a formation, while Clay's gel functions to displace liquid product from the dead volume of a storage tank. Sydans is concerned with plugging formation anomalies so that fluid is subsequently diverted by the gel into the formation matrix, thereby forcing bypassed oil contained in the matrix toward a production well. Sydans is faced with the problem of recovering oil from rock, *i.e.*, from a matrix which is porous, permeable sedimentary rock of a subterranean formation where water has channeled through formation anomalies and bypassed oil present in the matrix. Such a problem is not reasonably pertinent to the particular problem with which Clay was involved — preventing loss of stored product to tank dead volume while preventing contamination of such product. Moreover, the subterranean formation of Sydans is not structurally similar to, does not operate under the same temperature and pressure as, and does not function like Clay's storage tanks. *See In re Ellis*, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) ("the similarities and

differences in structure and function of the invention disclosed in the references . . . carry far greater weight [in determining analogy]").

A person having ordinary skill in the art would not reasonably have expected to solve the problem of dead volume in tanks for storing refined petroleum by considering a reference dealing with plugging underground formation anomalies. The Board's finding to the contrary is clearly erroneous. Since Sydans is non-analogous art, the rejection over Hetherington in view of Sydans cannot be sustained.

CONCLUSION

For the foregoing reasons, the decision of the Board is

REVERSED.

U.S. Patent and Trademark Office Trademark Trial and Appeal Board

In re Sharky's Drygoods Co.

Serial No. 74/017,286

Decided March 4, 1992

Released May 12, 1992

TRADEMARKS AND UNFAIR TRADE PRACTICES

1. Types of marks — Geographical and geographically misdescriptive marks (§327.09)

Examining attorney, in order to demonstrate that mark is geographically deceptive, must first establish that it is geographically deceptively misdescriptive by showing that mark in question consists of or incorporates term that denotes geographical location which is neither obscure nor remote, that there is goods/place association between goods on which mark is used and geographical place named by term, and that the goods do not, in fact, originate in that geographical place; misdescription must, in addition, be likely to affect customer's purchasing decision.

2. Types of marks — Geographical and geographically misdescriptive marks (§327.09)

Fact that Paris is well-known geographical place, that it is center for haute couture, and that applicant's goods do not come from there is not sufficient to demonstrate that "PARIS BEACH CLUB" is geographically

¹ Sydans refers to an anomaly, one of two general region types in an oil-bearing geological formation, as "a volume or void space [e.g., 'streaks, fractures, fracture networks, vugs, solution channels, caverns, washouts, cavities, etc.'] in the formation having very high permeability relative to the matrix [the other region type, consisting of homogeneous porous rock]."

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